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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/270,676	03/16/1999	TAKAHIRO ABE	566.370337XO	2808

20457 7590 02/11/2004

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EXAMINER

HAROLD, JEFFEREY F

ART UNIT	PAPER NUMBER
2644	10

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/270,676

Applicant(s)

ABE ET AL.

Examiner

Jefferey F. Harold

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. ***Claims 5-8*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington (United States Patent 5,546,454) in view of legal precedence making separable MPEP 2144.04. Regarding **claim 5**, Harrington discloses an automatic call distributor with telephonic call holding system. In addition, Harrington discloses a communication system comprising call distributor (20), which reads on claimed "exchange", and internal telephonic units 32A-N, which read on claimed "plurality of telephones" accommodated in the exchange, as disclosed at column 3, lines 46-55 and exhibited in figure 1, wherein each of the telephones includes: hold button (54) and line buttons (44A-C) to implicitly place a call on hold, which reads on claimed hold instruction accept means for accepting a hold instruction from an operator, as disclosed at column 5, line 55 through column 6, line 8 and exhibited in figure 2; and

transfer button (47) and line buttons (44A-C), which read on claimed "hold releasing instruction accept means", for accepting a hold releasing instruction from the operator as disclosed at column 7, lines 6-34 and exhibited in figures

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4A-C, 5-9; main memory (26) and central control unit (24), which read on claimed "hold control means and hold information registration means", for holding a communication partner and for registering in the central control unit (24) and memory (26) information of the communication partner (either external telephone unit or internal telephone unit) which is on hold in accordance with the hold instructions from the telephone operator, as disclosed at column 6, lines 26-52 and exhibited in figure 1;

hold release means (operator pressing either a line key 44A-C or the transfer key 47) for searching, information of a communication partner specified by the hold release instruction from the hold information registration area (main memory 26 and central control unit 20) and releasing the hold thereby connecting the communication partner to the telephone as disclosed at column 7, line 7 through column 11, line 42 and exhibited in figures 4A-C, 5-6, however, Harrington fails to disclose wherein the hold control means and the hold release means are separate from the transfer means. However, the examiner maintains that it was well known in the art to provide wherein the hold control means and the hold release means are separate from the transfer means, as taught by legal precedence-making separable.

MPEP 2144.04 provide for legal precedent as source of supporting rationale. Specifically 2144.04V.C. discloses where it is obvious to separate components of a prior art invention without changing its functions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Harrington by specifically providing

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wherein the hold control means and the hold release means are separate from the transfer means, for the purpose of expanding the system capacity.

Regarding **claim 6**, Harrington discloses everything claimed as applied above (see claim 5), in addition Harrington discloses a plurality of common line buttons (44AC) and are provided as the hold instruction accept means and the hold release instruction accept means, and there are provided a plurality of display means (screen 38 and status indicator lights 46A-C) each of which is provided in association with each of the common line buttons, accepts a hold instruction and is turned on when the corresponding common hold button is pushed, and accepts a hold release instruction and is turned off when the corresponding common hold button is pushed during the turn-on state thereof, wherein the hold information registration means (memory 26 and central control unit 24) associates the information of connected telephone held in accordance with the hold instruction from the telephone with the common hold button accepting the hold instruction concerned to register the information in the hold information registration area, and

the hold release means (line button 44A-C) searches, in accordance with the hold release instructions from the telephone, the information corresponding to the common hold button accepting the hold release instruction from the hold information registration area, and releases the hold of the communication partner specified by the searched information, thereby connecting the communication partner to the telephone as disclosed at column 7, line 7 through column 11, line 42 and exhibited in figures 4AC, 5-6, however, Harrington fails to disclose

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wherein the hold control means and the hold release means are separate from the transfer means. However, the examiner maintains that it was well known in the art to provide wherein the hold control means and the hold release means are separate from the transfer means, as taught by legal precedence-making separable.

MPEP 2144.04 provide for legal precedent as source of supporting rationale. Specifically 2144.04V.C. discloses where it is obvious to separate components of a prior art invention without changing its functions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Harrington by specifically providing wherein the hold control means and the hold release means are separate from the transfer means, for the purpose of expanding the system capacity.

Regarding **claims 7 and 8**, they are interpreted and thus rejected for the reasons set forth above in the rejection of claims 5 and 6.

### ***Response to Arguments***

2. Regarding applicant's arguments with respect to newly added claims 5-8 have been considered but are moot in view of the new ground(s) of rejection as cited above.

### ***Conclusion***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F. Harold whose telephone number is (703) 306-5836. The examiner can normally be reached on Monday-Friday 9:30am-6pm.

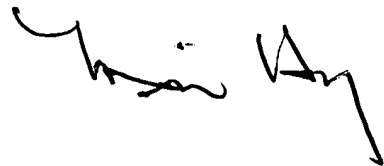
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4800.



JFH

February 4, 2004



MINGCHUN HARVEY  
PATENT EXAMINER